

REMARKS

In the Office Action<sup>1</sup> mailed June 19, 2009, the Examiner:

withdrew from consideration claims 32, 34, 36, 38, 40, 43, 47, 50, and 59-65 as being directed to a non-elected invention;

objected to claim 49;

rejected claims 1-31, 33, 35, 37, 39, 41, 42, 44-46, 48, 49, and 51-55 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter;

rejected claims 2-4, 11, 12, 18, 22, 27, 39, 41, 42, 44-46, 48, 49, 51, 52, and 57 under 35 U.S.C. § 101 for failing to provide a credible specific and substantial utility;

rejected claims 2-4, 11, 12, 18, 22, 27, 39, 41, 42, 44-46, 48, 49, 51, 52, and 57 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement;

rejected claims 1, 5-9, 13, 14, 17, 19-21, 24-26, 28-30, 53-56, and 58 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,735,253 to Chang et al. ("Chang");

rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of the Examiner's taking of Official Notice ("Official Notice");

rejected claims 15 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of "An Adaptive Perceptual Quantization Algorithm for Video Coding" by Chung et al. ("Chung");

rejected claim 31, 33, 35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over Chang in view of U.S. Patent 6,058,143 to Golin ("Golin");

objected to claim 23 as being dependent upon a rejected base claim but allowable if rewritten in independent form; and

---

<sup>1</sup> The Office Action may contain statements characterizing the related art, case law, and claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

did not reject any of claims 2-4, 11, 12, 18, 22, 27, 39, 41, 42, 44-46, 48, 49, 51, 52, and 52 in view of any prior art under §§ 102 or 103.

As an initial matter, Applicant thanks the Examiner for the indication of allowed claims and allowable subject matter.

Applicant hereby amends claims 1-22, 24-26, 28-31, 33, 35, 37, and 56, cancels claims 23, 27, 32, 34, 36, 38-55, and 57-65 without prejudice or disclaimer, and adds new claims 66 and 67. Claims 1-22, 24-26, 28-31, 33, 35, 37, 56, 66, and 67 remain pending.

Regarding the Examiner's objection to claim 49, the claim has been canceled, rendering this objection moot.

Applicant respectfully traverses the rejection of claims 1-31, 33, 35, 37, 39, 41, 42, 44-46, 48, 49, and 51-55 under 35 U.S.C. § 101, with regard to the Examiner's allegation that the claims are directed to non-statutory subject matter. Claims 23, 27, 39, 41, 42, 44-46, 48, 49, and 51-55 have been canceled, rendering their rejection moot. Furthermore, Applicant has amended independent claim 1 to recite "[a] video signal processing method for processing video signals containing video material by a server, the server executing instructions to perform the method comprising the steps of . . . ." Thus, the claim recites the positive execution of instructions by a server for performing the claimed method steps, and the claim is therefore tied to a particular machine and falls within one of the recognized classes of statutory subject matter. Claims 2-22, 24-26, 28-31, 33, 35, and 37 are dependent on independent claim 1, and are therefore statutory at least due to their dependence. Accordingly, Applicant

respectfully requests the withdrawal of the rejection of claims 1-22, 24-26, 28-31, 33, 35, and 37 under 35 U.S.C. § 101.

Applicant respectfully traverses the rejection of claims 2-4, 11, 12, 18, 22, 27, 39, 41, 42, 44-46, 48, 49, 51, 52, and 57 under 35 U.S.C. § 101, with regard to the Examiner's allegation that the claims are not supported by either a substantial and specific asserted utility or a well established utility. Claims 27, 39, 41, 42, 44-46, 48, 49, 51, 52, and 57 have been canceled, rendering their rejection moot.

Regarding the remaining claims, the Examiner cites to specific language in the claims, e.g. "hold picture" as was used in dependent claim 2 prior to this amendment, alleging, "the specification does not disclose what the 'hold' picture is, and therefore, the claimed invention is not supported by either a substantial and specific asserted utility or a well established utility." Office Action at 4. Applicant respectfully disagrees that the claims lack a specific and substantial utility.

MPEP § 2107 sets forth the "Guidelines for Examination of Applications for Compliance with the Utility Requirement." See also Utility Examination Guidelines, 66 Fed. Reg. 1092 (Jan. 5, 2001). The Guidelines are "to be followed by Office personnel in the evaluation of any patent application for compliance with the utility requirements of 35 U.S.C. 101 and 112." MPEP § 2107. The Examiner must review the claims and written description to determine whether there is "any specific and substantial utility that is credible." Id.

If at any time during the examination, it becomes readily apparent that the claimed invention has a well-established utility, do not impose a rejection based on lack of utility. An invention has a well-established utility if (i) a person of ordinary skill in the art would immediately appreciate why the

invention is useful based on the characteristics of the invention (e.g., properties or applications of a product or process), and (ii) the utility is specific, substantial, and credible.

MPEP § 2107(II)(A)(3) (emphasis added). Only when a *prima facie* showing of lack of utility has been properly established does the burden shift to the applicant to rebut it. See MPEP § 2107(II); see also MPEP § 2107.02(VI); In re Brana, 51 F.3d at 1566 n.17, 34 U.S.P.Q.2d at 1441 n.17 ("Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility.").

Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* showing of lack of utility for Applicant's claimed invention. As a practical matter, the Examiner did not reject independent claim 1 for lack of utility. Therefore, a claim dependent on an independent claim logically cannot lack utility at least because the dependent claim includes the utility of the independent claim. For at least this reason, the Examiner's allegation of a lack of utility cannot stand.

Furthermore, the Examiner's allegation of a lack of utility appears to incorrectly apply the relationship between 35 U.S.C. §§ 101 and 112, first paragraph. "A deficiency under the utility prong of 35 U.S.C. 101 also creates a deficiency under 35 U.S.C. 112, first paragraph." See In re Brana, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995); In re Jolles, 628 F.2d 1322, 1326 n.10, 206 USPQ 885, 889 n.11 (CCPA 1980); In re Fouche, 439 F.2d 1237, 1243, 169 USPQ 429, 434 (CCPA 1971) ("If such compositions are in fact useless, appellant's specification cannot have taught how to use them.").

While Applicant notes that §§ 101 and 112, first paragraph, are intertwined based on the theory of lack of utility, it is important that the Examiner not confuse the requirements of enablement under § 112, first paragraph, with the requirements of an invention being "useful" as required under § 101.

It is important to recognize that 35 U.S.C. 112, first paragraph, addresses matters other than those related to the question of whether or not an invention lacks utility. These matters include **whether the claims are fully supported by the disclosure** (*In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991)), whether the applicant has provided an **enabling disclosure** of the claimed subject matter (*In re Wright*, 999 F.2d 1557, 1561-1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)), whether the applicant has provided an **adequate written description** of the invention and whether the applicant has disclosed the best mode of practicing the claimed invention . . . .

The fact that an applicant has disclosed a specific utility for an invention and provided a credible basis supporting that specific utility does not provide a basis for concluding that the claims comply with all the requirements of 35 U.S.C. 112, first paragraph.

To avoid confusion during examination, any rejection under 35 U.S.C. 112, first paragraph, based on grounds other than "lack of utility" should be imposed separately from any rejection imposed due to "lack of utility" under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph.

MPEP § 2107.01(IV) (emphases added).

Applicant respectfully asserts that the Examiner has misapplied the relationship between § 101 utility rejection and § 112, first paragraph, enablement rejection. Indeed, this is supported by the fact that the Examiner's § 112, first paragraph rejection does not even provide any connection to the Examiner's lack of utility argument. As set forth in the MPEP, "[t]he 35 U.S.C. 112, first paragraph, rejection should be set out as a

separate rejection that incorporates by reference the factual basis and conclusions set forth in the 35 U.S.C. 101 rejection. The 35 U.S.C. 112, first paragraph, rejection should indicate that because the invention as claimed does not have utility, a person skilled in the art would not be able to use the invention as claimed, and as such, the claim is defective under 35 U.S.C. 112, first paragraph." MPEP § 2107.01(IV) (emphases added).

The Examiner's § 112, first paragraph rejection, however, does not follow these guidelines. Rather, the Examiner alleges that, with respect to the above recited "hold picture" of claim 2, that "the claim(s) contain[] subject matter . . . which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention." Office Action at 5. Thus, it appears that the Examiner believes the claims recite subject matter that is not sufficiently supported by Applicant's disclosure. However, even assuming the Examiner was correct in this situation, as noted above, a rejection for lack of enablement under § 112, first paragraph, does not imply that the claim lacks utility. A § 101 lack of utility rejection does not automatically result from a failure to comply with the written disclosure or enablement requirements of §112, first paragraph.

Regardless of whether the claims are supported under the written description and enablement requirements of § 112, first paragraph, the Examiner has not provided any explanation sufficient to establish a *prima facie* case that the claims lack utility.

Finally, even assuming, *arguendo*, that the Examiner established a *prima facie* case of lack of utility, and the burden to rebut it shifted to Applicant, Applicant

respectfully submits that the evidence of record demonstrates a specific and substantial utility.

As explained in the MPEP, if the burden shifts to the applicant, then the applicant should provide evidence that “[e]xplicitly identifi[es] a specific and substantial utility for the claimed invention” and that evidence of a “specific and substantial utility” was well established at the time of filing. MPEP § 2107(II). Only where the totality of the record continues to show that the asserted utility is not specific, substantial, and credible should a rejection based on lack of utility be maintained.” Id. Applicant respectfully submits that the evidence of record demonstrates a specific and substantial utility, which clearly rebuts any possible *prima facie* case of lack of utility.

Applicant’s specification is replete with descriptions of the claimed invention, which demonstrate a specific and substantial utility for the claimed invention. For example, see the Specification at pages 5 and 6, wherein several specific and substantial uses are outlined for the claimed invention. One of ordinary skill in the art would instantly recognize the claimed method and apparatus to be “useful,” as the claimed subject matter provides “a well-defined and particular benefit to the public.”

In re Fisher, 421 F.3d 1365, 1371, 76 USPQ2d 1225, 1230 (Fed. Cir. 2005).

For all of the aforementioned reasons, Applicant respectfully submits that the § 101 rejection for lack of utility is in error and should be withdrawn.

Applicant respectfully traverses the rejection of claims 2-4, 11, 12, 18, 22, 27, 39, 41, 42, 44-46, 48, 49, 51, 52, and 57 under 35 U.S.C. § 112, first paragraph. Claims 27, 39, 41, 42, 44-46, 48, 49, 51, 52, and 57 have been canceled, rendering their rejection moot.

Regarding claim 2, the Examiner alleges that "the specification does not disclose what the 'hold' picture is, and therefore, the claim(s) contain[] subject matter . . . which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention." Office Action at 5. Applicant has amended the claim to recite "field pictures" rather than "hold pictures." Such an amendment is supported by at least page 21, lines 5-6 of Applicant's specification. Accordingly, claim 2 is fully supported by Applicant's specification.

Regarding claims 11 and 12, the Examiner alleges that "the specification does not disclose what the 'an array of motion vectors' picture is, and therefore, the claim(s) contain[] subject matter . . . which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention." Office Action at 6.

Respectfully, Applicant note that the claim does not recite an "array of motion vectors picture," as alleged by the Examiner. See Office Action at 6. Rather, the claim provides a step of representing metadata "as an array of motion vectors . . ." Applicant asserts that the concepts of arrays and motion vectors are well known to one of ordinary skill in the art, and one of ordinary skill in the art would clearly recognize how data may be represented in an array data structure. Furthermore, the originally filed claim itself provides support for such recitations. "In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it." MPEP 608.01(l). As originally filed claims 11 and 12 are considered

part of the original specification, the recitations in claims 11 and 12 are fully supported by Applicant's specification.

Regarding claims 18 and 22, the Examiner alleges that "the specification does not disclose what the 'a life-time of features points' is, and therefore, the claim(s) contain[] subject matter . . . which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is more nearly connected, to make and/or use the invention." Office Action at 6. Applicant has amended the claim to remove reference to a "life-time," and therefore, amended claims 18 and 22 are fully supported by Applicant's specification.

For all of the aforementioned reasons, Applicant respectfully submits that the § 112, first paragraph rejection for lack of enablement is in error and should be withdrawn.

Applicant respectfully traverses the rejection of claims 1, 5-9, 13, 14, 17, 19-21, 24-26, 28-30, 53-56, and 58 under 35 U.S.C. § 102(e) as being anticipated by Chang. Claims 53, 53, and 58 have been canceled, rendering their rejection moot.

As noted in the Office Action, "[t]he prior art of record does not anticipate or render obvious the step of associating the transcoding hints metadata to the separated A/V segments compris[ing] the steps of: calculating a number of new feature points per frame; determining if the number of new feature points exceeds some thresholds; and selecting based on said determination one of several transcoding hints states." Office Action at 14. As such, independent claim 1 is amended to include allowable subject matter from claim 23, which is canceled by this Amendment. Similarly, independent

claim 56 is amended to recite similar subject matter previously recited in now canceled claim 23.

Dependent claims 5-9, 13, 14, 17, 19-21, 24-26, and 28-30 depend from independent claim 1, and are allowable at least based on their dependence.

Applicant respectfully traverses the rejections of claims 10, 15, 16, 31, 33, 35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Chang, Official Notice, Chung, and Golin.

Claims 10, 15, 16, 31, 33, 35, and 37 depend on independent claim 1. As noted above, combinations of Chang, Official Notice, Chung, and Golin do not teach or suggest each and every element of independent claim 1. Accordingly, combinations of Chang, Official Notice, Chung, and Golin, fail to teach or suggest each and every element of dependent claims 10, 15, 16, 31, 33, 35, and 37, and the claims are allowable at least due to their dependency on an allowable base claim. For at least this reason, claims 10, 15, 16, 31, 33, 35, and 37 distinguish over combinations of Chang, Official Notice, Chung, and Golin.

Finally, newly added claims 66 and 67 recite subject matter previously recited in independent claims 1 and 56, and their inclusion does not raise issues of new matter. As claim 66 depends on allowable claim 1, and claim 67 depends on allowable claims 56, the claims are allowable at least due to their dependency on an allowable base claim.

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 18, 2009

By:   
Trenton J. Roche  
Reg. No. 61,164